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APPLICATION NO.	FIL	ING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,716	6 07/18/2000		Kyoji Saito	P19789	9554
7055	7590	05/20/2004		EXAMINER	
		RNSTEIN, P.L.C	PHAN, TAM T		
1950 ROLA RESTON, V		CE PLACE		ART UNIT	PAPER NUMBER
•				2144	
				DATE MAILED: 05/20/200-	4 /

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)					
065 4 41 0	09/618,716	SAITO, KYOJI					
Office Action Summary	Examiner	Art Unit					
	Tam (Jenny) Phan	2144					
The MAILING DATE of this communication appeared for Reply	ppears on the cover sheet with the	correspondence address					
A SHORTENED STATUTORY PERIOD FOR REP THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR of after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a recommunication of the period for reply is specified above, the maximum statutory perions for the period for reply within the set or extended period for reply will, by statue than three months after the mail earned patent term adjustment. See 37 CFR 1.704(b).	1. 1.136(a). In no event, however, may a reply be tileply within the statutory minimum of thirty (30) danged will apply and will expire SIX (6) MONTHS fror ute, cause the application to become ABANDON	imely filed ys will be considered timely. In the mailing date of this communication. ED (35 U.S.C. § 133).					
Status							
1)⊠ Responsive to communication(s) filed on 13	February 2004						
3) Since this application is in condition for allow							
Disposition of Claims							
4) ☐ Claim(s) 13-36 is/are pending in the applicat 4a) Of the above claim(s) is/are withdom 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 13-36 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and	rawn from consideration.						
Application Papers							
9)☐ The specification is objected to by the Examination 10)☑ The drawing(s) filed on 18 July 2000 is/are: Applicant may not request that any objection to the Replacement drawing sheet(s) including the correction. The oath or declaration is objected to by the	a) accepted or b) objected to ne drawing(s) be held in abeyance. Section is required if the drawing(s) is o	ee 37 CFR 1.85(a). bjected to. See 37 CFR 1.121(d).					
Priority under 35 U.S.C. § 119							
a) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority docume 2. Certified copies of the priority docume 3. Copies of the certified copies of the priority docume application from the International Bure * See the attached detailed Office action for a li	nts have been received. Ints have been received in Applicationity documents have been received in PCT Rule 17.2(a)).	tion No ved in this National Stage					
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) ☐ Interview Summar Paper No(s)/Mail [
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date		Patent Application (PTO-152)					

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DETAILED ACTION

1. This application has been examined. Amendment A received on 02/13/2004 has been entered. Claims 1-12 are cancelled. Claims 13-36 are new. Claims 13-36 are presented for examination.

Priority

- 2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-d, which papers have been placed of record in the file.
- 3. The effective filing date for the subject matter defined in the pending claims in this application is 11/11/1999.

Claim Rejections - 35 USC § 103

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 5. Claims 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al. (U.S. Patent Number 6,374,291), hereinafter referred to as Ishibashi in view of RFC2305 (RFC2305 "A Simple Mode of Facsimile Using Internet MAIL" March 1998– Referred to PTO 892 for details).
- 6. Regarding claim 13, Ishibashi disclosed an image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network and a controller configured to convert the attached data into image data (Abstract, column 4 lines 24-34, lines 44-67, column 5 lines 1-7).

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7. Ishibashi taught the invention substantially as claimed. However, Ishibashi did not expressly teach the controller further being configured to judge whether or not the received e-mail is an error mail [unwanted mail], based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail.

- 8. Ishibashi suggested exploration of art and/or provided a reason to modify the image apparatus with the judging unwanted email feature (Figure 3(b), Figure 4, column 6 lines 34-44).
- 9. RFC 2305 disclosed teachings of judging whether or not the received e-mail is an unwanted mail, based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail (Sections 2.2.1, 5.1, 5.2.1, 5.2.2).
- 10. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the image receiving apparatus of Ishibashi with the teachings of RFC2305 to include the judging unwanted mail feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provided should be part of the Internet security infrastructure (Section 5.1). In addition, judging unwanted mail feature would also help save resources since unwanted bulk mails consume resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).
- 11. Regarding claim 14, the Ishibashi and RFC2305 disclosed an image receiving apparatus further comprising a printer configured to print the image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the

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printer prints the converted image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

- Regarding claim 15, the Ishibashi and RFC2305 disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).
- 13. Regarding claim 20-22, the method corresponds directly to the image receiving apparatus of claims 13-15, and thus these claims are rejected using the same rationale.
- 14. Since all the limitations of the claimed invention were disclosed by the combination of Ishibashi and RFC2305, claims 13-15 and 20-22 are rejected.
- 15. Claims 16-19 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al. (U.S. Patent Number 6,374,291), hereinafter referred to as Ishibashi in view of RFC2305 (RFC2305 "A Simple Mode of Facsimile Using Internet MAIL" March 1998– Referred to PTO 892 for details) and further in view of Chen et al. (U.S. Patent Number 5,832,208), hereinafter referred to as Chen.
- 16. Regarding claim 13, Ishibashi disclosed an image receiving apparatus receiving an e-mail, the e-mail including a header and a body, the body including a message, the message including an image data part, the image receiving apparatus comprising: a receiver configured to receive an e-mail with data attached, via a computer network; and

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a controller configured to convert the attached data to image data (Abstract, column 4 lines 24-34, lines 44-67, column 5 lines 1-7).

- 17. Ishibashi taught the invention substantially as claimed. However, Ishibashi did not expressly teach the controller further being configured to judge whether or not the received e-mail is an error mail [unwanted mail].
- 18. Ishibashi suggested exploration of art and/or provided a reason to modify the image apparatus with the judging unwanted email feature (Figure 3(b), Figure 4, column 6 lines 34-44).
- 19. RFC 2305 disclosed teachings of judging whether or not the received e-mail is an unwanted mail when the received e-mail is a multi-part structure (Sections 2.2.1, 5.1, 5.2.1, 5.2.2, 5.2.4).
- 20. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the image receiving apparatus of Ishibashi with the teachings of RFC2305 to include the judging unwanted mail feature in order to maintain interoperability with Internet mail (Section 5.1) since any security to be provided should be part of the Internet security infrastructure (Section 5.1). In addition, judging unwanted mail feature would also help save resources since unwanted bulk mails consume resources and therefore undesirable (Section 5.2.2 paragraphs 1-2).
- The combination of Ishibashi and RFC2305 taught the invention substantially as claimed. However, the combination of Ishibashi and RFC2305 did not expressly teach searching for a predetermined image data fixed code [signature code] in the image data part of the e-mail [body of the email] and to judge that the received e-mail is an error

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mail [unwanted mail] when the predetermined image data fixed code [signature code] is detected.

- 22. RFC2305 suggested exploration of art and/or provided a reason to modify the image receiving apparatus of Ishibashi and RFC2305 with the searching of signature code in a multi-part mail structure (Section2 2.2.4, 5.2.4).
- 23. Chen disclosed a controller [agent] for searching a predetermined image data fixed code [signature code] in the image data part of the e-mail when the received e-mail is a multi-part structure, and to judge that the received e-mail is an error mail when the predetermined image data fixed code [signature code] is detected (column 1 lines 49-56, column 2 lines 18-34, lines 47-52, column 3 lines 16-32).
- 24. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Ishibashi and RFC2305 with the teachings of Chen to include the searching of signature code in a multi-part mail structure in order to provide a more efficient method of identify unwanted mail since Email From addresses are trivial to fake, so that using on the MAIL FROM or From header is not sufficient (RFC2305, Section 5.2.4).
- 25. Regarding claim 17, the RFC2305 and Chen combined disclose an image receiving apparatus wherein the controller searches for the predetermined image data fixed code in the whole received e-mail when the received e-mail is a single-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected (RFC2305, Sections 2.2.4, 5.2.1; Abstract, Figure 3, column 2 lines 18-34, lines 47-52, lines 17-47).

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26. Regarding claim 18, the Ishibashi and RFC2305 disclosed an image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, and converts the abstracted predetermined information into image data, and the printer prints the converted image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).

- 27. Regarding claim 19, the Ishibashi and RFC2305 disclosed image receiving apparatus further comprising a printer configured to print image data, wherein the controller, when an error mail is detected, abstracts predetermined information from the e-mail, edits the abstracted predetermined information, and converts the edited information into image data, and the printer prints the converted predetermined image data (Ishibashi, Abstract, Figures 11, 12, column 8 lines 34-57; RFC2305, Sections 2.3.2, 5.2.4).
- 28. Regarding claim 23-26, the method corresponds directly to the image receiving apparatus of claims 16-19, and thus these claims are rejected using the same rationale.
- 29. Regarding claim 27, the combination of Ishibashi, RFC2305, and Chen disclosed an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part, the image receiving apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server; a converter configured to convert the attached data into image data (Ishibashi, Abstract, column 4 lines 24-34, lines 44-67, column 5 lines 1-7); a memory [database table] configured to store a predetermined image data fixed code, an

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image data fixed code being contained in the image data part (RFC2305, Section 5.2.2); and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of -the received e-mail, and to judge that the received email is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory (RFC2305, Sections 2.2.1, 5.1, 5.2.1, 5.2.2, 5.2.4; Chen, column 1 lines 49-56, column 2 lines 18-34, lines 47-52, column 3 lines 16-32).

- 30. Regarding claim 32, the method corresponds directly to the image receiving apparatus of claims 27, and thus is rejected using the same rationale.
- 31. Since all the limitations of the claimed invention were disclosed by the combination of Ishibashi, RFC2305, and Chen, claims 16-19, 23-26, 27, and 32 are rejected.
- 32. Claims 27, 30, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wing (U.S. Patent Number 6,650,440), in view of Paul (WO 99/33188).
- Regarding claim 27, Wing disclosed an image receiving apparatus connected to a server and receiving an e-mail, when the received e-mail is an error mail, the e-mail including a header and a body, the body including a message, the message including an image data part, the image receiving apparatus comprising: a receiver configured to receive an e-mail to which data is attached, via the server and a converter configured to

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convert the attached data into image data (Figure 2, Figure 3, column 1 lines 31-42, column 2 lines 16-29).

- Wing taught the invention substantially as claimed. However, Wing did not expressly teach a memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part; and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of -the received e-mail, and to judge that the received email is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory [filtering unwanted mail].
- 35. Wing suggested exploration of art and/or provided a reason to modify the image receiving apparatus with the filtering unwanted mail feature (Abstract).
- 36. Paul disclosed a memory [inclusion/exclusion lists] configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part; and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail (page 7 lines 9-16, page 8 lines 14-27, page 9 lines 15-24, page 12 lines 21-28) and to judge that the received email is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory [filtering unwanted mail] (Abstract, page 7 lines 9-16, lines 26-31, page 8 lines 23-27).

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37. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the image receiving apparatus of Wing with the teachings of Paul to include the filter unwanted mail feature in order to control delivery of unwanted facsimile e-mail since users might not be eager to receive unwanted mail (page 1 lines 22-23) and unwanted mail might also reduce users' productivity at the workplace (page 1 lines 26-28).

- 38. Regarding claim 32, the method corresponds directly to the image receiving apparatus of claim 27, and thus is rejected using the same rationale.
- 39. Regarding claim 30, the limitations of claim 30 are similar to the limitations of claim 27, and thus the claim is rejected using the same rationale.
- 40. Regarding claim 35, the method corresponds directly to the image receiving apparatus of claims 30, and thus is rejected using the same rationale.
- 41. Since all the limitations of the claimed invention were disclosed by the combination of and Wing and Paul, claims 27, 30, 32, and 35 are rejected.
- 42. Claims 28-29, 33-34, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wing (U.S. Patent Number 6,650,440), in view of Paul (WO 99/33188) and further in view of Iwazaki (U.S. Patent Number 6,687,742).
- 43. The combination of Wing and Paul disclosed an image receiving apparatus with all the limitations listed in claim 27 rejection above.
- 44. The combination of Wing and Paul taught the invention substantially as claimed. However, Wing and Paul did not expressly teach the predetermined header fixed message comprises [X:mailer:] field.

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45. Paul suggested exploration of art and/or provided a reason to modify the image receiving apparatus with the [X:mailer:] field (page 8 lines 14-27).

- 46. Iwazaki disclosed a predetermined header fixed message comprises [X:mailer:] field.
- It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined apparatus of Wing and Paul to include the [X:mailer:] in the filter unwanted feature since it would be preferable to includes all identification data needed to determine the status of incoming mail (Paul, lines 14-18). Most users preferred to implement filtering based upon additional list categories, such as the "TO", "BCC", "CC", and "SUBJECT" email headers as well as other headers (Paul, lines 21-27).
- 48. Regarding claim 29, Iwazaki image receiving apparatus wherein the predetermined image data fixed code comprises SUqk (Figure 9).
- 49. Regarding claim 33-34, the method corresponds directly to the image receiving apparatus of claims 28-29, and thus is rejected using the same rationale.
- 50. Regarding claim 31 and 36, the limitation of these claims are similar to the limitation of claim 29, and thus these claims are rejected using the same rationale.
- 51. Since all the limitations of the claimed invention were disclosed by the combination of Wing, Paul, and Iwazaki, claims 28-29, 33-34, 31, and 36 are rejected.

Response to Arguments

52. Applicants' arguments with respect to the pending claims have been considered but are most in view of the new ground(s) of rejection. Referred to above rejections for details.

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53. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

- Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
- 56. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

> William Cuchlinski SPE Art Unit 2144 703-308-3873

May 15, 2004

WILLIAM A. CUCHLINSKI, JR. SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2600